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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,224	06/12/2001	James Paul Kimmel JR.		3716

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JAMES P. KIMMEL, JR.
832 MEADOWVIEW DRIVE
KENNETT SQUARE, PA 19348

EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,224

Applicant(s)

KIMMEL, JAMES PAUL

Examiner

Matthew s Gart

Art Unit

3625

mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

All of the drawings contain informal text and labels. Proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Specification

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "A computerized method of defining and valuing legal research instructions and specifications, and of ordering and pricing legal research, for an electronic legal research ordering and pricing system, etc." mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or affect the underlying process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by

Walker U.S. Patent No. 5,862,223.

Referring to claim 1. Walker discloses a computerized method of defining and valuing research instructions and specifications, and of ordering and pricing research, for an electronic research ordering and pricing system, comprising the steps of:

- Receiving and storing primary research instruction and specification categories that identify essential research parameters (column 7, lines 5-30);
- Receiving and storing sub-categories within each primary research instruction and specification category (Figure 15);
- Receiving and storing specific research instructions and specifications (column 7, lines 5-30);
- Setting each said sub-category and each said research instruction and specification as either a categorical guide or a research option that can be selected by a purchaser client (Figure 15);
- Receiving and storing a numerical value for each research option that can be selected by said purchaser client when ordering research (Figure 15);
- Receiving and storing price ranges that correspond to the said numerical values (Figure 8);
- Receiving and storing delivery time and means options that can be selected by a purchaser client and prices for said options (Figure 8 and column 7, lines 5-30);
- Organizing and displaying said research instruction and specification primary categories, sub-categories, options and delivery time and means options for viewing and selection by a purchaser client in placing a research order (column 7, lines 5-30);

- Receiving and storing the research instruction and specification options selected by said purchaser client in placing a research order (column 7, lines 5-30);
- Receiving and storing the research delivery time and means options selected by said purchaser client in placing a research order (column 7, lines 5-30);
- Receiving and storing the issue to be researched, as stated by said purchaser client in placing a research order (column 7, lines 5-30);
- Calculating the total numerical value of the research order placed by said purchaser client by totaling the numerical values stored in said electronic research ordering and pricing server for each research instruction and specification option selected by said purchaser client (Figure 8 and column 21, lines 12-26);
- Calculating an interim price for the research order placed by said purchaser client by identifying the price range stored in said electronic research ordering and pricing server that corresponds to the said total numerical value for the research order placed by said purchaser client (Figure 8 and column 21, lines 12-26);
- Calculating the final price of the research order placed by said purchaser client by adding to or deducting from said interim price the stored price associated with the delivery time and means options selected by said purchaser client in placing a research order (Figure 8 and column 21, lines 12-26);
- Organizing and displaying a summary of the research instruction and specification options and the delivery time and means options selected by said

purchaser client, together with the said final price for the research order, for viewing and purchase by said purchaser client (Figure 16, 17, 18 and 19); and

- Organizing and conveying to a research provider a summary of the research instruction and specification options and the delivery time and means options selected by said purchaser client, together with the said final price for the research order and customer and payment information for use in fulfilling said order (Figure 16, 17, 18 and 19).

Referring to claim 2. Walker further discloses a method comprising the steps of:

- Editing said research instruction and specification categories, sub-categories and options (column 19, line 1 to column 20, line 49);
- Editing said setting of research categorical guides and legal research options (column 19, line 1 to column 20, line 49);
- Editing said setting of numerical values for said research options (column 19, line 1 to column 20, line 49);
- Editing said setting of corresponding price ranges (column 19, line 1 to column 20, line 49);
- Editing said delivery time and means options and prices (column 19, line 1 to column 20, line 49).

Referring to claim 3. Walker further discloses a method wherein the primary research instruction and specification option categories are type of analysis, controlling law, forum, sources of law, subject matter and type of research (column 17, lines 13-35).

Referring to claim 4. Walker further discloses a method wherein said delivery time and means prices are percentage adjustments made to said price ranges that correspond to the numerical value of selected legal research options, and wherein the said final price is reached by making said percentage adjustment to the said interim price based upon the stored and selected delivery time and means percentage adjustments (column 7, lines 5-30);

Referring to claim 5. Walker further discloses a method wherein discounts and premiums corresponding to the number and type of orders placed and number and type of services requested are received and stored in said electronic research ordering and pricing server, and wherein the said final price is further adjusted to reflect said stored discounts and premiums (column 7, lines 5-30).

Referring to claim 6. Walker further discloses a method comprising the steps of:

- Modifying the legal research order placed by the purchaser client by allowing said purchaser client to select or deselect legal research instruction and specification options (column 7, lines 5-30 and column 19, line 1 to column 20, line 49);
- Modifying the legal research order placed by the purchaser client by allowing said purchaser client to select or deselect delivery time and means options (column 7, lines 5-30 and column 19, line 1 to column 20, line 49); and
- Recalculating the said interim and final prices based upon said modifications made by the purchaser client (column 7, lines 5-30 and column 19, line 1 to column 20, line 49).

Referring to claim 7. Walker further discloses a method comprising the steps of:

- Accepting and storing more than one legal research order at a time by said purchaser client and calculating a price for the entire order to include the price for all legal research orders placed (column 7, lines 5-30 and column 19, line 1 to column 20, line 49);
- Accepting and storing the deletion of one or more of several legal research orders by said purchaser client and recalculating the price for the entire order to include the price for all legal research orders placed (column 7, lines 5-30 and column 19, line 1 to column 20, line 49).

Referring to claims 8-12. Claims 8-12 are rejected under the same rationale as set forth above in claims 1-7.

Referring to claims 13-14. Claims 13-14 are rejected under the same rationale as set forth above in claims 1-7.

Referring to claims 15-21. Claims 15-21 are rejected under the same rationale as set forth above in claims 1-7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Usitalo, Patent Application Publication, US 2002/0099679, July 25, 2002, discloses a virtual interactive expert solution system.

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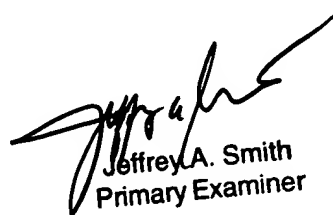
Peter Sinton, "Two Attorneys Hang Their Shingles Online", San Francisco Chronicle, San Francisco, Calif.: Aug 2, 2000, discloses an online marketplace where law firms can purchase legal research.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG
June 7, 2004



Jeffrey A. Smith
Primary Examiner